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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,578	01/08/2002	Jacques Durocher	85493-423	1432

7590

10/06/2003

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EXAMINER

KLEBE, GERALD B

ART UNIT

PAPER NUMBER

3618

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/038,578

Applicant(s)

DUROCHER, JACQUES

Examiner

Gerald B. Klebe

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 7-9 and 15-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 10-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 and 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Election / Restriction

1. Applicant's response to the restriction requirement set forth in the Office Action mailed 6/16/2003 electing, with traverse, the inventive species I illustrated in Figures 1-6, claims 1-6 and 10-14 considered reading thereon, is acknowledged.

While acknowledging the four species identified in the Office Action, Applicant traverses only the restriction requirement between species I (the embodiment shown in Figures 1-6) and species II (the embodiment shown in Figures 7-9).

Applicant's traversal states that the embodiments illustrated in Figures 1-6 and 7-9 are both patentable in a single patent application because the embodiment of the rear vibration absorption systems shown in Figures 1-6, and in Figures 7-9 are not patentably distinct, since "the shape of the rear vibration absorption insert 56 does not render these embodiments to be considered as being distinct species." Applicant continues by citing text from lines 18-25 on page 7 of the specification which concludes by stating that "Many variations of the designs of insert 56 are possible within the spirit and scope of the present invention." The examiner notes for the record that Applicant's statements that the shapes of the insert 56 are considered to be obvious variants, includes stating that such a variant may be one that includes a pocket of air or gas or a series of air pockets enclosed within the body of insert 56 and thus provides evidence on the record such that if the examiner finds one of these variants unpatentable over the prior art, Applicant's admission may be used in a rejection under 35 USC 103(a) of the other variant(s) so identified.

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Regarding Applicant's traversal of the restriction requirement that Figures 1-6 and figures 7-9 illustrate separate species, the traversal is not persuasive. The difference in the species I and the species II is that species I (Figures 1-6) embodies a vibration absorption system at the heel only of the outer sole, whereas the species II (Figures 7-9) provides a vibration absorption system comprising components at the toe as well as at the heel of the outer sole. Moreover, Applicant's disclosure makes numerous references to the various embodiments while pointing out their unique features. Therefore, Applicant's arguments traversing the requirement of species I and II are unpersuasive, and taken together with Applicant's failure to traverse the requirement of the other species III and IV, the examiner regards the restriction requirement to be proper and it is hereby made Final.

Regarding the pending claims of the application, the examiner agrees that claims 1-6 and 10-14 read on the elected species I and consequently, there being no allowable generic claim, claims 7-9 and 15-20 are withdrawn hereby from further consideration on the merits.

Claim Objections – Minor Informalities

2. The claims are objected to for the following informalities:

In claim 1 and in claim 10, each at line 6: the word "thereto" should be – thereinto --.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 1-4, 6, 10-11, and 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Burns et al. (US 5823543), cited by Applicant.

Burns et al. discloses an in-line roller skate (Fig 1, item 10) comprising: **(re: claim 1)** a chassis (18) carrying a plurality of aligned wheels; a skate boot (13) including an outsole (not separately numbered) and an upper to enclose and support a human foot, the outsole including means (14 and 16; refer col 3, lines 59-67) for mounting the chassis to the boot, the outsole further including a resilient component ((38 and/or 58; refer col 4, lines 8-9, and lines 18-19) inserted therinto for reducing shocks and vibrations transferred from the chassis to the human foot; and further **(re: claim 10)** wherein the chassis is mounted to the skate boot; and further **(re: claims 10 and 2)** the outsole further comprising a heel portion (16) and a front portion (14), the heel portion (16) including a fork-like structure (combination of 52 and 54) having upper (52) and lower (54) platforms defining a space therebetween for receiving the resilient component (58); and further **(re: claims 10 and 3)** the upper and lower platforms branching out from an intersecting portion of the fork-like structure and being adapted to flex at the intersecting portion for compressing the resilient component when the in-line roller skate is in normal use (refer col 4, lines 13ff); and further **(re: claims 4 and 11)** wherein the resilient component (58) is made of rubber or other suitable elastomeric material (refer col 4, line 27); and further **(re: claims 6 and 13)** wherein the outsole comprises a mounting bracket (combination of 54 and 56) mounting a rear portion of the chassis to the outsole extending from the lower platform (54), a mounting bracket extending from a front portion of the outsole for mounting a front portion of the chassis to the skate boot; and further **(re: claim 14)** wherein the outsole comprises a mounting bracket (combination 32 and 34) extending from a front portion of the outsole for mounting a front portion of the chassis to the skate boot.

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5. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Hilgarth (US 5961131), cited by Applicant.

Hilgarth discloses an in-line roller skate and boot including an outsole and an upper for enclosing and supporting a human foot, said outsole including means (14 and 19) for mounting the chassis (12) to the skate boot (11; and refer col 3, line 65 to col 4, line 14), the outsole further including a resilient component (21) inserted therein and wherein the outsole comprises a heel portion and a front portion, the heel portion including a fork-like structure (Fig 4a) having upper and lower platforms defining a space (24) therebetween for receiving the resilient component (refer col 4, lines 46-54).

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by any one of Chicoine (CA 2201814), Fullum (CA 2295778), or Joumard (FR 2742063), each of which is cited by Applicant.

Each of Chicoine/Fullum/Joumard discloses an in-line roller skate comprising: a chassis carrying a plurality of aligned wheels; a skate boot including an outsole and an upper; the outsole including means for mounting the chassis to the skate boot, the outsole further including a resilient component inserted thereto for reducing shocks and vibrations transferred from the chassis. (Chicoine: refer Fig 2, and pages 7-8; Fullum: refer Fig 1, and item 35; Joumard: refer Fig 1 and item 4.)

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burns et al. (US 5823543) in view of Kilgore et al. (US 6343639), both cited by Applicant.

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a. As discussed above, Burns et al. discloses (Fig 10 all of the features of the invention except that Burns et al. uses a resilient component comprising an elastomeric element (item58); Burns et al. is silent as to whether the resilient element has an air pocket.

b. However, Kilgore et al. teaches an elastomeric heel resilient cushion member for a sport shoe heel in the form of a hollow elastomeric cylindrical column with an insert having a height substantially less than the height of the column.

c. It would have been obvious to one of ordinary skill in the art at the time the instant invention was made, to have modified the resilient component of Burns et al. by substituting the hollow elastomeric cylinder of Kilgore et al. in order to have a suspension for the skate that permits the insertion of an inflatable gas-filled bladder which could be adjustably inflatable so that the stiffness of the element would be adjustable to suit the use of the skate for skating environments having different shock and vibration load ranges, as suggested by the reference at column 2, lines 46-54.

Prior Art made of Record

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art of Lenoir teaches an in-line roller skate with detachable boot having a cushioned outsole; Seltzer teaches an integrally molded boot and roller or ice skate combining the outsole of the boot and the wheel truck or frame of the skate wherein the heel portion includes a fork-like structure having upper and lower platforms defining a space therebetween; Goodwin et al. teaches a boot with resilient bladder insertable into the heel portion of the outer sole of the boot; Lyden teaches a boot having a resilient outer sole wherein the heel portion comprises a fork-like structure having upper and lower platforms defining a space therebetween and for insertion of a resilient component thereinto; Passke et al. teaches a boot with a resilient outer sole having an embedded air sac in the heel portion; Burns et al. (-329) teaches an in-line skate suspension with a shock absorber resilient member cushioning the heel of the boot. These

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references also teach various other structures having features in common with some of the limitations disclosed in the instant application

Conclusion

10. Any inquiry concerning this or earlier communication(s) from the examiner should be directed to Gerald B. Klebe at 703-305-0578, fax 703-308-2571, M-F 8:00 AM- 4:30 PM ET, or to Supervisory Patent Examiner Brian L. Johnson, Art Unit 3618, at 703-308-0885.



gbklebe / Art Unit 3618 / 27 September 2003


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9/29/03